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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 647,479	09 29 2000	Barry Huston Meyrick	PM-271586 SM	7070

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04 17 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,479

Applicant(s)

MEYRICK ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 4/8/02.

In light of the new grounds of rejection as set forth in paragraph 4 below, the finality of the previous office action mailed 1/14/02 is withdrawn, and the following action is non-final.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 3, 5-8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 732381, alone, or alternatively, in view of Lent et al. (U.S. 5,837,042).

The rejection is adequately set forth in paragraph 5 of the office action mailed 8/8/01, Paper No. 4, and is incorporated here by reference.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 732381 alone, or alternatively, in view of Lent et al. as applied to claims 3, 5-8, and 11-13 above, and further in view of Suzuki et al. (U.S. 6,153,001).

The difference between EP 732381 alone, or alternatively, in view of Lent et al. and the present claimed invention is the requirement in the claims of benzyl alcohol.

Suzuki et al., which is drawn to ink jet ink, disclose the use of benzyl alcohol in addition to the use of water-soluble organic solvent such as N-methyl-2-pyrrolidone as disclosed by EP

732381, in order to produce an ink with suitable drying time that produces clear images (col.12, lines 30-31 and 48-62).

In light of the motivation for using benzyl alcohol disclosed by Suzuki et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such solvent in the ink of EP 732381 in order to produce an ink with suitable drying time that produces clear images, and thereby arrive at the claimed invention.

Response to Arguments

5. Applicants' arguments regarding Knable et al. (U.S.4,532,276) and Batlaw et al. (U.S. 5,429,841) have been fully considered but are moot in view of the discontinuation of these references against the present claims.

6. Applicants' arguments filed 4/8/02 have been fully considered but with the exception of arguments relating to Knable et al. and Batlaw et al., they are not persuasive.

Specifically, applicants argue that:

EP 732381 discloses crosslinked urethane polymers not non-crosslinked urethane as presently claimed.

It is noted that the present claims require a water-dissipatable polyurethane not a non-crosslinked polyurethane. While EP 732381 discloses the use of crosslinked polyurethane, it is noted that page 5, lines 34-35 of EP 732381 discloses that the crosslinked polyurethane is in the form of an aqueous dispersion, i.e. the polyurethane is in fact water-dissipatable as presently

claimed. Additionally, page 9, lines 7-8 of EP 732781 discloses that solvents are used in order to improve the dispersability of the aqueous phase.

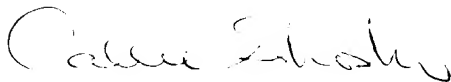
Thus, it is clear that although EP 732381 discloses crosslinked polyurethane, EP 732781 still meets the claimed limitation that the polyurethane is water-dissipatable.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Callie E. Shosho
Examiner
Art Unit 1714



Callie Shosho
April 15, 2002